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TRADEMARK

Attorney Docket No. 000291-009701US

01-09-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Date of Deposit: January 5, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service by "First Class Mail" service under 37 CFR 1.8 on the date indicated above and is addressed to the Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3514.

TOWNSEND AND TOWNSEND AND CREW LLP

By: _____

Mary L. Shapiro

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JOSEPH ENTERPRISES, INC.

Opposer,

v.

NEOPETS, INC.

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Application No.: 76/389,091
Filed: March 28, 2002
Published: December 30, 2003
Mark: CHIA

Commissioner for Trademarks
BOX TTAB FEE
2900 Crystal Drive
Arlington, Virginia 22202-3514

Sir:

Opposer JOSEPH ENTERPRISES, INC., a California Corporation, having a business situs and address at 425 California Street, Suite 1300, San Francisco, California 94104, believes that it will be damaged by the registration of the mark **CHIA** shown in U.S. Trademark Application Serial No. 76/389,091, filed March 28, 2002 by NEOPETS, INC., a Delaware corporation, having a principal place of business at 412 West Broadway Avenue, Suite 300, Glendale, CA 91204, and hereby opposes registration thereof.

As grounds for the opposition, Opposer alleges that:

1. By this application, Applicant is seeking to obtain registration upon the Principal Register of the mark **CHIA** for use with "toys, games and playthings, namely, toy vehicles, toy action figures and accessories for use therewith; dolls, doll clothing and doll accessories; children's multiple activity toys; plush toys; stuffed toys; plastic and vinyl toy characters and toy animals; toy figures; radio-controlled toy vehicles; mechanical toys; wind-up toys; water squirting toys; musical toys; inflatable toys; jigsaw puzzles; equipment sold as a unit for playing board, parlor, skill and action, card, role-playing, and electronic hand-held unit for playing games."

2. Opposer owns incontestable United States registrations for the mark **CHIA**: Registration No. 1,859,361 for "growing mix for plants; kit comprising plastic cup and saucer, growing medium, and seeds; clay animals used as planters, and clay replicas of plants used as planters, and flower, vegetable and herb seeds" and Registration No. 2,090,156 for "clothing for men, women and children, namely, shirts, shorts, pants, sweatshirts, tee shirts, hats, caps, jackets, underwear, socks, ties, scarves, and sweaters." Opposer also owns incontestable registrations for the mark **CHIA HEAD** (Registration No. 2,076,769) for "terra cotta figurines used as planters" and the mark **CHIA TREE** (Registration No. 1,605,619) for "clay replicas of plants used as planters."

3. Opposer is the owner of additional registrations and applications for "**CHIA**" marks, including but not limited to: Registration No. 2,306,061 for the mark **CHIA PET** for "clay animals used as planters;" Registration No 2,773,363 for the mark **CHIA HERB GARDEN** for a "kit comprising terra cotta cup and saucer, growing medium, and seeds;"

Application No. 76/416,852 for the **CHIA** mark for "plush toys; puppets; toys, namely, baby multiple activity toys, bath toys, crib toys, infant toys, party favors in the nature of small toys, plastic character toys, building blocks, mobiles, basket balls, baseballs, beach balls, foot balls, rubber action balls, sport balls, and volley balls; games, namely, board games, card games, party games, video games, and video game interactive hand held remote controls for playing electronic games;" and Application No. 76/416,818 for the **CHIA** mark for "hobby craft sets for gardening comprising seed, growing pots, and growing media; holiday decorations for Christmas." (hereafter collectively referred to as "Opposer's Marks" or the "**CHIA** Marks").

4. True and correct copies of Opposer's registrations referenced above from the official records of the USPTO Trademark Electronic Search System are attached hereto as Exhibit A.

5. Since at least as early as 1977, Opposer has used the **CHIA** trademark for clay animals used as planters. The goods described under the aforementioned registrations have been extensively advertised and marketed under Opposer's Marks throughout the United States. By virtue of its efforts and the expenditure of considerable sums for promotional activities and the high quality of its products, Opposer has created widespread goodwill under Opposer's Marks throughout the United States in connection with such goods.

6. As a result of Opposer's extensive advertising and marketing, Opposer's Marks are famous marks that are well known to purchasers.

7. Opposer's Marks have become a valuable asset of Opposer and principal symbols of its extensive goodwill. By reason of such wide use of Opposer's Marks, the trade and

purchasing public have come to recognize Opposer's Marks as signifying Opposer and as identifying Opposer as the source of the goods offered under Opposer's Marks.

8. Application Serial No. 76/389,091 for the proposed **CHIA** mark, opposed herein, was filed as an Intent-to-Use application on March 28, 2002, after registrations for Opposer's Marks had issued (with the exception of Registration No 2,773,363, which issued on October 14, 2003).

9. Applicant's proposed mark is identical to the mark registered by Opposer in Registration Nos. 1,859,361 and 2,090,156 and so resembles Opposer's Marks so as to be likely to cause confusion, mistake, or deception in the trade and among purchasers as to the source, origin, or sponsorship of Applicant's goods.

10. The goods identified in Application Serial No. 76/389,091 and the goods offered under Opposer's Marks are related and are the type which could be sold in the same channels of trade and to the same prospective purchasers.

11. Because Applicant's proposed mark so resembles Opposer's Marks, is used on related goods, and Applicant offers its goods to purchasers or prospective purchasers of the goods offered under Opposer's Marks, the trade and purchasing public are likely to believe that Applicant's goods originate from Opposer or from an entity that is in some way associated with Opposer, thus resulting in damage and detriment to Opposer and its reputation, as well as to the purchasing public.

12. Registration and use of Applicant's proposed mark shown in the opposed application are likely to dilute Opposer' famous **CHIA** Marks.

13. Opposer has challenged Applicant's use of the **CHIA** mark, the mark that is the subject of the application opposed herein. Opposer is the plaintiff in a lawsuit against Applicant, alleging trademark infringement, dilution, and violation of the anti-cybersquatting consumer protection act, which was filed on June 3, 2002 in the United States District Court, Northern District of California.

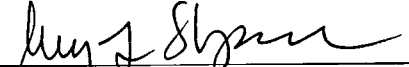
14. Registration of Applicant's proposed mark shown in the opposed application will result in damage to Opposer under the provisions of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and § 43(c) of the Lanham Act, 15 U.S.C. § 1125 (c), and pursuant to the allegations stated above.

WHEREFORE, Opposer requests that the registration sought by Applicant in the United States Application Serial No. 76/389,091 be refused and that this Notice of Opposition be sustained in favor of Opposer.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Date: January 3, 2004

BY: 

Paul W. Vapnek

Mary L. Shapiro

Attorneys for Opposer

JOSEPH ENTERPRISES, INC.

Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Telephone: (415) 576-0200
Facsimile: (415) 576-0300

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Please charge the fee of \$300.00 to Townsend and Townsend and Crew LLP, Deposit Account No. 20-1430. Please charge any additional fees that may be due, or credit any overpayment, to our Deposit Account No. 20-1430.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Date: January 5, 2004

BY: Mary L. Shapiro
Mary L. Shapiro
Attorneys for Opposer

Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
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to record:

Record 9 out of 13**Check Status***(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)***Typed Drawing****Word Mark** CHIA**Goods and Services** IC 001. US 001. G & S: growing mix (potting mix) for plants. FIRST USE: 19920814. FIRST USE IN COMMERCE: 19920814

IC 021. US 002 010. G & S: kit comprising plastic cup and saucer, growing medium, and seeds; clay animals used as planters, and clay replicas of plants used as planters. FIRST USE: 19770908. FIRST USE IN COMMERCE: 19770908

IC 031. US 001 030. G & S: flower, vegetable and herb seeds. FIRST USE: 19920814. FIRST USE IN COMMERCE: 19920814

Mark Drawing Code

(1) TYPED DRAWING

Serial Number 74406094**Filing Date** June 23, 1993**Current Filing Basis** 1A**Original Filing Basis** 1A**Published for Opposition** August 2, 1994**Registration Number** 1859361**Registration Date** October 25, 1994

Owner (REGISTRANT) JOSEPH ENTERPRISES, INC. CORPORATION CALIFORNIA
425 California Street, Suite 1300 San Francisco CALIFORNIA 94104

Attorney of Record Paul W. Vapnek

Prior Registrations 1090927;1605619;1763853

Type of Mark TRADEMARK

Register PRINCIPAL-2(F)

Affidavit Text SECT 15. SECT 8 (6-YR).

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Word Mark CHIA
Goods and Services IC 025. US 022 039. G & S: clothing for men, women and children, namely, shirts, shorts, pants, sweatshirts, tee shirts, hats, caps, jackets, underwear, socks, ties, scarves, and sweaters. FIRST USE: 19960417. FIRST USE IN COMMERCE: 19960417
Mark Drawing Code (1) TYPED DRAWING
Serial Number 75123119
Filing Date June 21, 1996
Current Filing Basis 1A
Original Filing Basis 1B
Published for Opposition January 14, 1997
Registration Number 2090156
Registration Date August 19, 1997
Owner (REGISTRANT) Joseph Enterprises, Inc. CORPORATION CALIFORNIA 425 California Street Suite 1300 San Francisco CALIFORNIA 94104
Attorney of Record Paul W. Vapnek
Type of Mark TRADEMARK

Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
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Typed Drawing

Word Mark	CHIA HEAD
Goods and Services	IC 021. US 002 013 023 029 030 033 040 050. G & S: terra cotta figurines used as planters. FIRST USE: 19950915. FIRST USE IN COMMERCE: 19950915
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74685515
Filing Date	June 7, 1995
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	April 15, 1997
Registration Number	2076769
Registration Date	July 8, 1997
Owner	(REGISTRANT) Joseph Enterprises, Inc. CORPORATION CALIFORNIA 425 California Street Suite 1300 San Francisco CALIFORNIA 94104
Attorney of Record	PAUL W. VAPNEK
Prior Registrations	1090927;1605619;1859361
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CHIA" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
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Record 13 out of 13**Check Status***(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)***Typed Drawing**

Word Mark	CHIA TREE
Goods and Services	IC 021. US 002 030. G & S: CLAY REPLICAS OF PLANTS USED AS PLANTERS. FIRST USE: 19891004. FIRST USE IN COMMERCE: 19891004
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74007654
Filing Date	December 4, 1989
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	April 17, 1990
Registration Number	1605619
Registration Date	July 10, 1990
Owner	(REGISTRANT) JOSEPH ENTERPRISES CORPORATION CALIFORNIA SUITE 1300 425 CALIFORNIA STREET SAN FRANCISCO CALIFORNIA 94104
Attorney of Record	PAUL W. VAPNEK
Prior Registrations	1090927
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CHIA" APART

FROM THE MARK AS SHOWN

Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20010505.
Renewal	1ST RENEWAL 20010505
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Typed Drawing

Word Mark	CHIA PET
Goods and Services	IC 021. US 002 013 023 029 030 033 040 050. G & S: clay animals used as planters. FIRST USE: 19770908. FIRST USE IN COMMERCE: 19770908
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75584901
Filing Date	November 6, 1998
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	October 12, 1999
Registration Number	2306061
Registration Date	January 4, 2000
Owner	(REGISTRANT) JOSEPH ENTERPRISES, INC. CORPORATION CALIFORNIA 425 California Street, Suite 1300 San Francisco CALIFORNIA 94104
Attorney of Record	Paul W. Vapnek
Prior Registrations	1605619;1763853;1823950;1859361;2076769;2090156
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CHIA" APART

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Typed Drawing

Word Mark CHIA HERB GARDEN

Goods and Services IC 021. US 002 013 023 029 030 033 040 050. G & S: Kit comprising terra cotta cup and saucer, growing medium, and seeds. FIRST USE: 19920814. FIRST USE IN COMMERCE: 19920814

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76459538

Filing Date October 21, 2002

Current Filing Basis 1A

Original Filing Basis 1A

Published for Opposition July 22, 2003

Registration Number 2773363

Registration Date October 14, 2003

Owner (REGISTRANT) JOSEPH ENTERPRISES, INC. CORPORATION CALIFORNIA
425 California Street, Suite 1300 San Francisco CALIFORNIA 94104

Attorney of Record Mary L. Shapiro

Prior Registrations 1763853;1823950;1859361;2306061;AND OTHERS

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HERB" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register PRINCIPAL-2(F)

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